

REMARKS

This communication is in response to the Official Action mailed November 19, 2004, the shortened statutory period for filing a response having expired on February 19, 2005. In this regard, Applicants submit herewith a three-month extension petition to reset the deadline for responding to the Official Action to and including May 19, 2005. Applicants have canceled claims 93-94. Claims 39-63, 78-92, and 95-102 are pending. In view of the above amendments and below remarks, reconsideration of the Examiner's rejection is respectfully requested.

Claims 39-63 and 78-102 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, with respect to claim 39, the Examiner has stated that it does not appear that the specification as originally filed supports the limitation "said second porous structure being substantially free of said oxidation catalyst." However, as discussed in the specification (for example, at page 18, lines 26-31), there is provided a second porous structure (designated 5, 5' in Fig. 1) that has dimensions such that the reducing agent (HC) can come into contact with a reduction catalyst (RED) associated therewith. As further demonstrated in Fig. 1, the oxidation catalyst (OX) is enclosed within the first porous structure (2,2') (See page 18, line 33 to page 19, line 3). Accordingly, the second porous structure is substantially free of the oxidation catalyst. It would be immediately recognized by those of ordinary skill in this art that a de minimis amount of oxidation catalyst present outside of the first porous structure or within the second porous structure that might occur, for example, as a result of the

manufacturing process, would not effect the invention. That is, the conversion of NO to NO₂ would still be favored. Accordingly, there is more than adequate support for this limitation.

The Examiner has also rejected claim 78, stating that there is insufficient support for the limitation "said oxidation catalyst . . . substantially excluded from said outer layer." With respect to this limitation, Applicants direct the Examiner to page 21, lines 29 to 34, which describes a method of making the structures claimed, wherein the content of the oxidation catalyst (OX) has been "reduced" in the outer layer of the first zeolite by means of partial ion-exchange. Referring to Fig. 1, there is shown a first porous structure having an outer layer (8), the oxidation catalyst being limited to or reduced in the outer layer. In another embodiment, this may be achieved by providing an additional zeolite crystal layer with a reduced content of oxidation catalyst by means of over-growth (See page 22, lines 3 to 14). Accordingly, Applicants respectfully submit that this limitation is also clearly supported by the specification.

The Examiner has also rejected claims 39-63 and 78-102 under 35 USC § 112, second paragraph. The Examiner contends that these claims are indefinite, and fail to particularly point out and distinctly claim the subject matter of the claimed invention. In particular, the Examiner objects to the word "substantially" as it appears in claims 39 and 78, stating that this is a relative term, not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

This rejection is respectfully traversed. Applicants respectfully submit that there is no legitimate basis for rejecting the claims based on the inclusion of the term "substantially." Indeed, issued U.S. patents are replete with

this term, and for good reason. It is, in fact, a necessary word to provide realistic protection for patentees. While it is clear from the present specification that, with respect to claim 1, the oxidation catalyst should be "enclosed within" the first porous structure, some small amount of oxidation catalyst could be present outside of the first porous structure without eliminating the benefits of the claimed invention. That is, the primary reaction of the total oxidation catalyst would be the conversion of NO to NO₂ over reactions (E) and (F) (See page 5). Similarly, with respect to claim 78, some small amount of oxidation catalyst could be present in the outer layer, and this would not alter the effect of the invention. On the other hand, an infringer should not be permitted to adopt this invention and at the same time attempt to avoid liability by including a small amount of oxidation catalyst either (1) in the second porous structure (or otherwise outside of the first porous structure) (with respect to claim 39) or (2) in the outer layer (with respect to claim 78).

Moreover, it is also clear from the case law that language such as "substantially" is perfectly acceptable in such circumstances, and does not violate the provisions of § 112. *In re Mattison*, 509 F.2d 563, 184 U.S.P.Q. 484 (C.C.P.A. 1975) is a case where the Board's application of § 112 to the language "substantially increase the efficiency of the compound as a copper extractant" was reversed. In *Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 U.S.P.Q. 568 (Fed. Cir. 1984), later appeal 756 F.2d 1574, 225 U.S.P.Q. 357 (Fed. Cir. 1985), the court again confirmed the fact that use of "substantially equal to" was not indefinite. See also *Andrew Corp. v. Gabriel Elecs., Inc.*, 847 F.2d 819, 6 U.S.P.Q.2d 2010 (Fed. Cir. 1988). It is therefore respectfully requested that this objection be withdrawn.

The Examiner has also rejected claims 93 and 94, stating that it is not clear how the embodiments disclosed would further limit claim 78. To expedite allowance of this case, Applicants have deleted these claims.


As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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